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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,991	12/02/2003	Michael M. Evans	2553.2.3	5217
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EXAMINER DANIELS, MATTHEW J				
ART UNIT		PAPER NUMBER		
1791				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,991

Applicant(s)

EVANS ET AL.

Examiner

MATTHEW J. DANIELS

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17-60, 62 and 63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-60, 62 and 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9 April 2009 has been entered.

Response to Amendment

2. The declarations under 37 CFR 1.132 filed 15 December 2008 and 30 December 2008 are insufficient to overcome the rejection of Claim 1 based upon Schills as set forth in the last Office action, but are sufficient to overcome the rejection of Claim 30 as set forth in the last Office Action. However, since Claim 1 now recites "proportioned to not flow as a liquid on the top surface," the declarations are believed to be moot in view of this amendment.

3. The 30 December 2008 Evans declaration has been fully considered. The declaration appears to assert commercial success and resolution of a long felt need. Additionally, the declaration asserts that Shills does not teach or suggest the claimed method. To the extent that the declaration asserts that the use of particular colors or custom colors causes commercial success or resolution of a long felt need, it is asserted that these aspects of the invention pertain to artistic aspects not distinguishable from the prior art. Additionally, there must be a nexus requirement between the evidence of nonobviousness and the claimed invention. See MPEP 716.01(b). It is unclear that the Evans declaration meets the nexus requirement since the

declaration merely points generally to an alleged failure by the Shills reference to provide the claimed invention. While the declaration points to the texture above the tile face (Evans Dec. ¶ 7) this statement appears to be only commensurate with Claim 30.

4. The 30 December 2008 Brasher declaration points to an aged appearance, texture, coloring which is unmet by the prior art (Brasher Dec. ¶ 7). The experimental roof achieved the look desired by providing a color scheme, texture, and natural casting of shadows still in place (Brasher Dec. ¶ 10 and 12). The Examiner submits that the aged appearance and coloring scheme are artistic aspects which do not distinguish the claimed invention from the prior art. The texture and casting of shadows are believed to be commensurate only with Claim 30, which provides a substantially zero slump medallion material which would cause the described shadowing by its resistance to slump.

5. The 30 December 2008 declaration points to a long felt need for the claimed invention. The Examiner submits that to the extent that the long felt need is met by the particular artistic appearance of the shingles, the Examiner submits that the particular artistic design is not a distinguishing feature. Shills demonstrates that it is conventional to randomly color the surface of a roof tile.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1-14 and 17-60** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "proportioned to not flow as a liquid on the top surface" in claim 1 does not appear to have support in the specification. This rejection would be overcome by incorporating the language of Claim 30 in place of the phrase "proportioned to not flow as a liquid on the top surface."
7. **Claims 3, 23, 24, and 29** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "proportioned to not flow as a liquid on the top surface." However, other claims which depend on Claim 1 appear to contradict Claim 1. For example, Claims 3, 23, 24, and 29 appear to recite mixtures which would be proportioned to flow as a liquid in view of their claimed low cement to aggregate ratio and high fraction of water. Only the zero slump material of Claim 30 would appear to avoid flowing as a liquid.

8. **Claim 3** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "comparatively low" in claim 3 is a relative term which renders the claim indefinite. The term "comparatively low" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 62 and 63** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaffee (US 1,993,086) in view of Shills (USPN 4743471). **As to Claims 62 and 63**, Chaffee teaches molding a plurality of roofing tiles (page 2, left col., lines 25-38), each tile having a top surface comprising an exposed portion (Fig. 16, item 12) and a covered portion (Fig. 16, item 19), as well as a length and width (implicit). Chaffee provides an accent color scheme comprising a cementitious material (page 2, left col., line 69 to page 2, right col., line 8) which would obviously require water and cement, and some aggregate colorant. Chaffee teaches installing the tiles with the exposed portion uncovered and covered portions covered (Fig. 17).

Chaffee is silent to the other claimed limitations regarding the hand throwing, forming medallions, substantially random distribution and variation in mass and height, the medallions having a shape and height controlled by an impact, repeating, and curing together the materials.

However, Shills teaches a process in which an accent color comprising cement, silica, and water (5:35-42) is applied by accelerating the colored material towards a tile (Fig. 5) to produce medallions that would implicitly be of random sizes, mass, and height. In view of the fact that the accent color comprises sand and cement, it is submitted that the forming would adopt a shape and height controlled by the impact of the material on the surface. Shills teaches that that process can be performed multiple times with different colors (14:35-42). Although Shills is silent to the application by hand, it is submitted that where the same process is performed using a machine, application by hand in the same manner would have been obvious. The Shills material and its substrate are both comprised of cement and would obviously be cured together (5:7-16).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Shills into that of Chaffee because (a) Chaffee clearly suggests a colored tile and tiles having various different colors (page 2), which the process of Shills is known to provide in tiles having a similar composition and purpose, or (b) Chaffee appears to be silent to any particular device or process of applying in the coating, but one would have found it obvious to select from among the known and substitutable coating devices capable of applying the colors of Chaffee, such as the process of Shills.

Allowable Subject Matter

10. Incorporation of the subject matter of **Claim 30** in place of the phrase "proportioned to not flow as a liquid on the top surface" in Claim 1 is suggested.

Response to Arguments

11. Applicant's arguments filed 15 December 2008 have been fully considered. Arguments with respect to all pending claims except Claim 62 are moot in view of the withdrawal of those rejections. With respect to Claim 62, Applicant argues that Shills teaches against the abrupt line of demarcation taught by Chaffee, and that there is no teaching or suggestion for creating the boundary of Chaffee's coating, nor the claimed medallions exclusively on the exposed portion of a tile. Applicants also argues that the declarations and exhibits militate against the arguments maintained by the Office Action.

12. The Examiner submits that Chaffee merely teaches that it is known to apply a colorant material only to the exposed face of a roofing tile. The Shills process would have been an obvious technique or alternative for applying colorant. Additionally, even the Monier sample demonstrated at the 8 April 2009 interview showed portions which were colored using an accent color and portions which were not colored using an accent color. Therefore, it is submitted that the Shills process obviously has the capability to provide colorant to selected portions of a tile. Applicant's demonstration does not suggest otherwise. With respect to the secondary considerations, it is submitted that there must be a nexus between the proffered evidence and the claimed invention. The artistic design does not appear to be a distinguishing feature since it depends on the skill of the artisan, rather than the application method. The texture may be

distinguishable, but only to the extent that the claims recite a composition that would produce the desired texture. Since the claims do not recite any composition that would result in the desired texture mentioned in the declarations, there does not appear to be a nexus.

13. Applicant's arguments filed 9 April 2009 have been fully considered. The arguments appear to be on the grounds that Applicant has amended the claims to articulate a range of materials proportions responsible, and that principally Claims 3 and 23-24 are directed to the composition of the material forming the medallions, whereas Claims 1 and 62 point out the significance of the physical properties and method in achieving the resulting tiles. Applicant also argues that Claim 63 is added to incorporate details requiring the method steps, materials and composition.

14. The Examiner submits that the amendment to Claim 1 ("proportioned to not flow as a liquid on the top surface") appears to contradict Claims 3, 23, and 24, unless it is the case that it is Applicant's position that the claimed mixtures of Claims 3, 23, and 24 would not flow as a liquid. Clarification is requested as to whether the mixtures now recited in Claims 3, 23, and 24 would flow as a liquid.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. DANIELS whose telephone number is (571)272-2450. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J. Daniels/
Primary Examiner, Art Unit 1791
6/19/09